

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	Art Unit: 1623
	)	
GANDHI, et al.	)	Examiner: PESELEV, E.
	)	
Serial No.: 10/529,393	)	Washington, D.C.
	)	
Filed: January 31, 2006	)	March 5, 2009
	)	
For: GLYCOSYLCERAMIDE	)	Docket No.: GANDHI=1A
ANALOGUES	)	
	)	Confirmation No.: 6722

PETITION TO VACATE

U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

S i r :

Pursuant to 37 CFR 1.181, Applicants petition for supervisory review of the action mailed December 15, 2008, and urge that the action be vacated as incomplete under Rule 1.104, as it fails to act upon (or even acknowledge the pendency of) claims 143-146 and 148-158.

The restriction requirement mailed June 11, 2008 acknowledged pendency of claims 1-105, 107-146 and 148-158. Applicants elected group V (43-50) with traverse on June 11, 2008. The traversal was deemed persuasive and the instant action said (page 2, first para.) that groups I, IV and VI would be rejoined. It can be seen from the restriction that group I is claims 1-30, 92-105, 107-139, 143-146 and 149-158, IV is 36-42, and VI is 52-65.

The present office action summary says that claims 1-142 are pending, ignoring claims 143-146 and 148-158. The only examined claims are 43-51<sup>1</sup>, even though by the terms of the rejoinder, 1-

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<sup>1</sup> The election had also argued that claim 51 should be in group V, and clearly the examiner accepted this argument.

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30, 36-42, 92-105, 107-139, 143-146 and 149-158 should also have been examined.

We appreciate that there was also a species restriction. However, applicants are entitled to examination of all claims which read on the elected species (the compound of claim 51) and applicants respectfully submit that at least the lead claims (1, 36, 52) of former groups I, IV and VI do so, as is evident from the comparative table on p. 2 of the August 28, 2008 election with traverse. Moreover, even if some of claims 143-146 and 148-159 did not read upon the elected species, they should have been identified as withdrawn, rather than treated as if they did not exist.

Applicants further note that the decision on this petition is necessary before any amendment can be filed, as an amendment must include claim identifiers, and it is unclear whether, e.g., claims 1, 36 and 52 should be identified as previously presented (per page 2, first para.) or as withdrawn (per the office action summary).

Respectfully submitted,

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